

Notice of Allowability

Application No.

10/540,916

Examiner

Robert R. Raevis

Applicant(s)

BERGAMASCO ET AL.

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1-7-08.
2. ☒ The allowed claim(s) is/are 14-26.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

The application has been amended as follows:

As to claim 20, replace "withdrawn" (line 1) with – previously presented--.

As to claim 21, replace "withdrawn" (line 1) with – previously presented--.

As to claim 22, replace "withdrawn" (line 1) with – previously presented--.

As to claim 23, replace "withdrawn" (line 1) with – previously presented--.

As to claim 24, replace "withdrawn" (line 1) with – previously presented--.

As to claim 25, replace "withdrawn" (line 1) with – previously presented--.

As to claim 26, replace "withdrawn" (line 1) with – previously presented--.

The above amendment was necessary, as claims 22-26 are allowable for the same reason that claim 14 is allowable.

Claims 14,22,24,26 are allowable over Challis as the reference does not teach the combination of "line spaced apart from said neutral axis" (line 9) with remaining claim limitations, as Challis's fiber 28 (corresponding to claim 14's line) on the neutral axis.

Claims 14,22,24,26 are allowable over Hodoc for the following: Hodoc teaches (Figure1) a method to measure relative rotation (note hinge 2; and "angular deflection" on first line of Para 33) of one object 1 relative to a second object 1 with a sensor 21,12,22, the sensor of which is identified as the sensor "according to DE 39 02 997" (i.e. Lessing, Para 34). Lessing teaches (Figures 1,2) particulars of the sensor employed in Hodoc, which includes a flexible element 2 whose two ends are respectively "secured" (Para 32, Hodac) to each of the objects, the element naturally having a neutral axis which does not change in length when bending, and defining at least one line (defined by the conductor 1) that is spaced from the neutral axis and parallel to the neutral axis (at least while the sensor 2/1 are entirely flat (and unstrained). When the sensor of Leasing is secured in Hodoc, the two objects 1 are rotated relative to one another via hinge 2, and the sensor measures the angle by which the sensor 1 is bent. The amount of light being measured through conductor is a function of the degree of "bending radius change" (line 47, col. 3, or Lessing) of the conductor 1, but that "bending radius" is indicative of a variation of the length of the conductor 1 as the conductor is not on the neutral axis. Hodoc expressly suggests use of that particular sensor. Also, Lessing's measurement of the variation of the amount of light passing through conductor 1 during bending is inherently a measure of the variation of length as the conductor 1 is not on the neutral axis and its length is varying with bending. *However, the Hodoc/Lessing combination does not teach "relative rotation being proportional to said length variation" (line 3-4 from last of claim 14, line 8 from bottom of claim 24, lines 4-5 from bottom of claim 26), as the sensor portions S of*

the conductor 1 do not expand in "length" in a manner "proportional" to "rotation" as the conductor does not remain parallel to the neutral axis during bending, which is necessary for the claimed proportional relationship.

The finality of the Office action mailed 7-5-07 was proper. Consider the wording of the second paragraph of MPEM 706.7(b):

The claims of an application for which a request for continued examination (RCE) has

been filed may be finally rejected in the action immediately subsequent to the filing of the

RCE (with a submission and fee under 37 CFR 1.114) where all the claims in the application after the entry of the submission under 37 CFR 1.114 (A) are drawn to the

same invention claimed in the application prior to the entry of the submission under 37

CFR 1.114, and (B) would have been properly finally rejected on the grounds and art of

record in the next Office action if they had been entered in the application prior to the filing

of the RCE under 37 CFR 1.114. (highlighting and underlining added)

The quoted passage suggests that "same invention" does not mean that the claims must be identical. The passage means that subsequent claims must employ limitations that suggest a distinctly different invention, i.e. different enough that the claims require new references. This is why practitioners commonly file Rule 116 amendments, whose resulting Advisories (new issues, new matter) ensure against obtaining a first action final in a subsequently filed (continuation, RCE) application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert R. Raevis whose telephone number is 571-272-2204. The examiner can normally be reached on Mon to Fri from 5:30am to 3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams, can be reached on 571-272-2204. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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